

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/965,003 Confirmation No. 2730
Applicants : Dutta et al.
Title: Patient Information Management System
Filed : September 27, 2001
TC/A.U. : 3626
Examiner : Michael Tomaszewski
Docket No. : AUS920010684US1
Customer No. : 48,916

BRIEF ON APPEAL

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P.O. Box 1450, Alexandria, VA 22313-1450

This is an appeal from the Office Action, mailed on August 10, 2007, finally rejecting claims 1-19. The fee for filing this Brief on Appeal is \$510.00, which is being paid electronically in conjunction with this filing. In addition, a Request for a One-Month Extension of Time is being filed and paid for electronically so that this Brief may be filed by March 10, 2008.

If these amounts are insufficient, or should any additional fees under 37 C.F.R. § 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from IBM Corporation, Deposit Account No. 09-0447.

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REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corp. (IBM) of Armonk, New York

RELATED APPEALS AND INTERFERENCES

A Notice of Appeal was filed on September 18, 2006. The Appeal Brief was filed on December 18, 2006. In response, prosecution was reopened with a non-final Office Action dated February 28, 2007.

STATUS OF CLAIMS

Claims 1-19 are currently pending and have been finally rejected.

Claims 1-6 and 8-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Mayaud (U.S. Patent No. 5,845,255) in view of Joao (U.S. Patent No. 6,283,761) and in view of Snowden et al. (U.S. Pat. Pub. No. 2002/0026332; herein after referred to as "Snowden").

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Mayaud in view of Snowden.

The rejection of each of claims 1-19 is appealed.

STATUS OF AMENDMENTS

All amendments to the claims have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

In general, the present invention relates to a system and method for managing medical patient prescription information. Each claim being appealed is summarized below.

Claim 1 is an independent claim directed to a method in which a patient prescription for a specified medication is received (**FIG. 5, Item 502**); the availability of insurance coverage is verified (**FIG. 5, Item 506**); an insurance payment category for the prescription is determined (**FIG. 5, Item 516**); and the payment category and the payment are transmitted to the insurance company without the medication information (**FIG. 5, Item 518**).

Claim 2 is a dependent claim directed to a method that includes all the elements of claim 1 in which the payment category is one of a list that includes brand name drugs, generic drugs and drugs that are not covered by an insurance plan (**FIG. 5, Item 516**).

Claim 3 is a dependent claim directed to a method that includes all the elements of claim 1 plus the element of dispensing the specified medication to the patient (**p. 1, ¶005**).

Claim 4 is a dependent claim directed to a method that includes all the elements of claim 1 plus the element of retrieving patient information and prescription information relating to the patient from a database (**FIG. 1, Item 114; p. 2, ¶016**).

Claim 5 is a dependent claim directed to a method that includes all the elements of claim 4 plus the element of storing the prescription that is being received and the corresponding payment information on the storage medium (**FIG. 1, Item 114; p. 2, ¶016**).

Claim 6 is a dependent claim directed to a method that includes all the elements of claim 1 plus the element of checking the received prescription against previous prescriptions for possible adverse reactions (**p. 1, ¶005**).

Claim 7 is an independent claim for a method in which patient prescription information is stored on a storage medium (**FIG. 1, Item 114; p. 2, ¶016**); unlimited access to the prescription information is provided to the patient; and limited access to the prescription information is provided to a third party if the access is authorized by the patient (**FIG. 5, Item 518**).

Claim 8 is an independent claim for a computer program product for managing patient prescription information that includes logic for receiving a patient prescription (**FIG. 5, Item 502**); logic for verifying the availability of insurance coverage (**FIG. 5, Item 506**); logic for verifying a payment category for the prescription (**FIG. 5, Item 516**); logic for collecting a payment for a patient (**FIG. 5, Items 506, 508, 510 and 514**); and logic for transmitting the payment category and the payment to an insurance company without including information related to the specific prescribed medication (**FIG. 5, Item 518**).

Claim 9 is a dependent claim directed to a computer program product that includes all the elements of claim 8 in which the payment category is one of a list that includes brand name drugs, generic drugs and drugs that are not covered by an insurance plan (**FIG. 5, Item 516**).

Claim 10 is a dependent claim directed to a computer program product that includes all the elements of claim 8 plus logic for dispensing the specified medication to the patient (**p. 1, ¶005**).

Claim 11 is a dependent claim directed to a computer program product that includes all the elements of claim 8 plus logic for retrieving patient information and prescription information relating to the patient from a database (**FIG. 1, Item 114; p. 2, ¶016**).

Claim 12 is a dependent claim directed to a computer program product that includes all the elements of claim 11 plus logic for storing the prescription that is being received and the corresponding payment information on the storage medium (**FIG. 1, Item 114; p. 2, ¶016**).

Claim 13 is a dependent claim directed to a computer program product that includes all the elements of claim 1 plus logic for checking the received prescription against previous prescriptions for possible adverse reactions (**p. 1, ¶005**).

Claim 14 is an independent claim directed to a system for managing patient prescription information that includes means to receive a patient prescription for a specified medication (**FIG. 5, Item 502**); means for verifying the availability of insurance coverage (**FIG. 5, Item 506**); means for verifying a payment category (**FIG. 5, Item 516**); means for collecting a payment for a patient (**FIG. 5, Items 506, 508, 510 and 514**); and means for transmitting the payment, payment category, but not the medication information, to the insurance company (**FIG. 5, Item 518**).

Claim 15 is a dependent claim directed to a system that includes all the elements of claim 14 in which the payment category is one of a list that includes brand name drugs, generic drugs and drugs that are not covered by an insurance plan (**FIG. 5, Item 516**).

Claim 16 is a dependent claim directed to a system that includes all the elements of claim 14 plus logic for dispensing the specified medication to the patient (**p. 1, ¶005**).

Claim 17 is a dependent claim directed to a system that includes all the elements of claim 14 plus logic for retrieving patient information and prescription information relating to the patient from a storage medium (**FIG. 1, Item 114; p. 2, ¶016**).

Claim 18 is a dependent claim directed to a system that includes all the elements of claim 17 plus logic for storing the prescription that is being received and the corresponding payment information on the storage medium (**FIG. 1, Item 114; p. 2, ¶016**).

Claim 19 is a dependent claim directed to a system that includes all the elements of claim 14 plus logic for checking the received prescription against previous prescriptions for possible adverse reactions (**p. 1, ¶005**).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether each claim of a group of claims consisting of claims 1-6 and 8-19 is unpatentable under U.S.C. §103(a) over Mayaud (U.S. Patent No. 5,845,255) in view of Joao (U.S. Patent No. 6,283,761) and further in view of Snowden et al. (U.S. Pat. Pub. No. 2002/0026332; herein after referred to as "Snowden").
2. Whether each claim of a group of claims consisting of claim 7 is unpatentable under U.S.C. §103(a) over Mayaud (U.S. Patent No. 5,845,255) in view of Joao (U.S. Patent No. 6,283,761) and further in view of Snowden (U.S. Pat. Pub. No. 2002/0026332).

ARGUMENTS OF APPELLANTS

1. **Whether each claim of a group of claims consisting of claims 1-6 and 8-19 is unpatentable under U.S.C. §103(a) over Mayaud (U.S. Patent No. 5,845,255) in view of Joao (U.S. Patent No. 6,283,761) and further in view of Snowden et al. (U.S. Pat. Pub. No. 2002/0026332; herein after referred to as “Snowden”).**

Each of claims 1-19 as summarized above include either an element of transmitting information to a entity for payment without including information concerning the particular medicine being prescribed or other wise limiting the information that a third party receives subject to patient approval. The primary question related to the grounds of rejection for each claim summarized above is as follows: Does Mayaud, Joao and Snowden describe “transmitting the payment category and the payment to the insurance company excluding the medication information”? The Final Office Action, dated 07/18/2006, (“Final Office Action,” or “F.O.A.”) admits that Joao “fails to expressly disclose a method comprising: ... (e) transmitting the payment category and the payment to the insurance company **excluding the medication information**” (O.A. page 4, *emphasis added*).

The F.O.A. relies upon Snowden and Joao to address the deficiency of Mayaud and Applicants contend that neither Snowden nor Joao teaches or suggests this element. Briefly, neither Joao nor Snowden mention the **exclusion** of information identifying a specific **medication** from a transmission for payment to an insurance company or other payment provider and the withholding of personal identification information is not the same.

The F.O.A. submits that “the combined teachings of Mayaud, Joao and Snowden, *in toto*, do indeed strongly suggest and teach the excluding of medical information in conjunction with the transmission of a request for payment.” (p.8, lines 14-17). Applicants submit that although combined references, *in toto*, do not suggest excluding **medication** information. The medical information withheld in Snowden is restricted to personal information designed to enable a particular patient’s information to be employed anomalously in a clinical study (Abstract, lines 5-10). In other words, the selectively withheld information is personal information related to a medical history rather than medication information and the reasons for withholding personal

information do not apply to the exclusion of medication information. Therefore, one does not suggest the other.

Joao does not provide that which Snowden and Mayaud lack. The excerpts from Joao cited in conjunction with the F.O.A. describe different combinations of participants to whom that system and method of Joao may apply (col. 12, lines 18-43); defines the scope of many terms employed in the Specification of Joao (col. 13, lines 7-20); describes the bidirectional flow of data between processing computers without specifically stating that certain information is excluded (col. 14, line 59 through col. 15, line 5); describes restrictions to database access corresponding to different healthcare providers (col. 19, lines 12-21); and describes earmarking sums of money for the payment of services (col. 37, lines 47-65).

The closest citation to the element of “transmitting the payment category and the payment to the insurance company excluding the medication information” is the Joao’s restriction to database access (col. 19, lines 12-21) but Applicants believe this is clearly distinguishable. Whether or not a particular healthcare provider is allowed access to information stored in a database is a different than whether information is excluded from a transmission made in conjunction with a payment request. In other words, Joao limits information in a database based upon provider rather than excluding a particular type of information, i.e. information regarding specific information, from payment requests to all providers.

In addition, the cited passages of Joao do not suggest “providing limited access to the prescription information to third parties **in response to authorization by the patient.**” Instead, Joao is directed to either secure communications (col. 4, lines 6-11) or simply limiting access to information (col. 7, lines 16-19 and col. 19, lines 7-12). Limiting access to information is a distinct and different operation than providing access to third parties **in response to authorization by the patient.**

The FOA acknowledges that neither Mayaud nor Joao provide the element of “excluding the medical information” while “transmitting the payment category and the payment to the insurance company.” In fact, prosecution of this application was reopened after an Appeal Brief, filed December 18, 2006, made this very argument. The FOA now relies on Snowden (¶¶[0065], [0079], [0085]) to provide this missing element. (FOA, p. 3, line 19). Applicants contend that

the FOA misconstrues Snowden's "medical histories" with Applicants' requests for payment. Although, Snowden suggests selectively withholding information related to a request for a medical history, Snowden neither suggests nor teaches the withholding of this information in conjunction with the transmission of a request for payment. In other words, a request for a medical history is not the same as a request for payment and Snowden is directed to limiting access to a database rather than withholding specific information from a specific type of transmission. Thus, Snowden does not provide the element that the FOA acknowledges both Mayaud and Joao lack, either by themselves or in combination.

2. **Whether each claim of a group of claims consisting of claim 7 is unpatentable under U.S.C. §103(a) over Mayaud (U.S. Patent No. 5,845,255) in view of Joao (U.S. Patent No. 6,283,761) and further in view of Snowden (U.S. Pat. Pub. No. 2002/0026332).**

In the most recent Final Office Action (FOA), the Examiner concedes that Mayaud does not expressly teach the element of “transmitting the payment category and the payment to the insurance company excluding the medication information.” (F.O.A., p. 3, lines 12-17). Joao is relied upon for this element and Applicants contend that this particular element is not suggested by Joao. Although the cited portions (col. 37, lines 47-65; Fig. 1) of Joao address payment, there is no suggestion of either “collection based upon a payment category” or “transmission of a payment category.” Joao only describes specific payment information such as, for example, “services rendered” rather than any categorization of payments as a basis for either collection or transmission. Therefore, Applicant submits that the current grounds of rejection are in error and that the pending claims are in condition for allowance. An reversal of the rejections is respectfully solicited.

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Respectfully submitted,

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CLAIMS APPENDIX
(Currently Pending Claims)

1. (Original) A method comprising:

receiving a patient prescription for a specified medication;

verifying availability of insurance coverage from an insurance company for the

patient prescription;

verifying an insurance payment category for the prescription;

collecting a payment from the patient based on the payment category; and

transmitting the payment category and the payment to the insurance company

excluding the medication information.
2. (Original) The method of claim 1 wherein the payment category is selected
from brand name, generic, and not covered.
3. (Original) The method of claim 1 further comprising dispensing the
prescription to the patient.
4. (Original) The method of claim 1 further comprising collecting patient
preexisting prescription information and patient insurance information from a storage medium.
5. (Original) The method of claim 4 further comprising recording the
prescription and the payment on the storage medium.

6. (Original) The method of claim 1 further comprising checking for adverse reactions between the patient prescription and at least one preexisting patient prescription.

7. (Original) A method comprising:
 storing patient prescription information on a storage medium;
 providing unlimited access to the prescription information to the patient; and
 providing limited access to the prescription information to third parties in response to authorization by the patient.

8. (Original) A computer program product in a computer readable medium for use in a data processing system, for managing patient prescription information the computer program product comprising:

instructions for receiving a patient prescription for a specified medication;
 instructions for verifying availability of insurance coverage from an insurance company for the patient prescription;
 instructions for verifying an insurance payment category for the prescription;
 instructions for collecting a payment from the patient based on the payment category; and
 instructions for transmitting the payment category and the payment to the insurance company exclusive of the medication information.

9. (Original) The product of claim 8 wherein the payment category is selected from brand name, generic, and not covered.

10. (Original) The product of claim 8 further comprising instructions for dispensing the prescription to the patient.

11. (Original) The product of claim 8 further comprising instructions for collecting patient preexisting prescription information and patient insurance information from a storage medium.

12. (Original) The product of claim 11 further comprising instructions for recording the prescription and the payment on the storage medium.

13. (Original) The product of claim 8 further comprising instructions for checking for adverse reactions between the patient prescription and at least one preexisting patient prescription.

14. (Original) System for managing patient prescription information system comprising:

receiving means for receiving a patient prescription for a specified medication;

first verifying means for verifying availability of insurance coverage from an insurance company for the patient prescription;

second verifying means for verifying an insurance payment category for the prescription;

collecting means for collecting a payment from the patient based on the payment category; and
transmitting means for transmitting the payment category and the payment to the insurance company exclusive of the medication information.

15. (Original) The system of claim 14 wherein the payment category is selected from brand name, generic, and not covered.

16. (Original) The system of claim 14 further comprising dispensing means for dispensing the prescription to the patient.

17. (Original) The system of claim 14 further comprising collecting means for collecting patient preexisting prescription information and patient insurance information from a storage medium.

18. (Previously presented) The system of claim further comprising recording means for recording the prescription and the payment on the storage medium.

19. (Original) The product of claim 18 further comprising checking means for checking for adverse reactions between the patient prescription and at least one preexisting patient prescription.

EVIDENCE APPENDIX

No evidence has been submitted in conjunction with this application.

RELATED PROCEEDINGS APPENDIX

There are currently no related proceedings associated with this application.